

Remarks

In the Office Action dated 04/19/2007, claims 14-17, 73-79, and 81-84 were rejected under 35 USC §102(e) as being anticipated by Cohen (U.S. Pat. 6,236,330). Claims 22-23 were rejected under 35 USC §103(a) as being unpatentable over Cohen in view of Official Notice. Claims 18-19 were rejected under 35 USC §103(a) as being unpatentable over Cohen in view of Cragun (U.S. Pat. 5,504,675). Applicant respectfully traverses the rejections for the reasons set forth below.

As an initial matter, Applicant appreciates the Office's acknowledgement of Applicant's perfected priority date of 04/28/1999.

In response to the rejections, Applicant respectfully maintains that the Office's citation of Cohen '330 as a §102(e) reference is erroneous. As noted in the Amendment and Response filed by Applicant on 01/11/2007, all of the claims of the present application are entitled to an effective filing date of 04/28/1999. As also noted in the Amendment and Response filed by Applicant on 01/11/2007, Cohen '330 has an actual filing date of 10/12/1999. Cohen '330 purports to claim priority to application serial number 09/185,061 ("the Cohen Parent"), now U.S. 6,060,993, as a continuation-in-part. As a continuation-in-part, Cohen '330 includes additional disclosure that was not present in the Cohen Parent (Cohen '993). **In fact, much of the additional disclosure added in Cohen '330 is improperly relied upon by the Office to reject Applicant's claims (most notably, col. 5, lines 5-12, of Cohen '330).** The teachings of Cohen '330 relied upon by the Office are not entitled to a reference date that predates 10/12/1999 unless the Cohen Parent (Cohen '993) provides adequate support for such teachings in accordance with 35 U.S.C. §112. See MPEP 2136.03.

An issued U.S. Patent is prior art under 35 USC §102(e) as of its earliest effective filing date. MPEP 2136.03 However, if an issued U.S. patent claims priority to a prior application, including a provisional application, the issued U.S. patent may be entitled to an earlier §102(e) date. In order to have an earlier §102(e) effective date that corresponds to the filing date of an earlier application, the issued U.S. patent must: (1) have at least one claim which is fully supported by the earlier application; and (2) the relevant subject matter in the U.S. patent must also be fully supported by the earlier application in accordance with 35 USC §112, ¶ 1. *In re*

*Wertheim*, 646 F.2d 527, 209 USPQ 554 (CCPA 1981). In fact, some subject matter in an issued U.S. patent may be entitled to an earlier effective 102(e) date, while other subject matter in that same patent is not.

The Board of Patent Appeals and Interferences (BPAI) recently dealt with the issue of the Office relying on the filing date of an earlier application in order to establish a critical reference date for subject matter in a later-filed patent reference. In *Ex parte Traversat, et al.*, the BPAI emphasized that the Office bears the burden to produce the factual basis for its rejection. (Appeal 2007-2225, Application 10/054,809, decided August 31, 2007, at p. 8).<sup>1</sup> In particular, the BPAI stated as follows:

[T]he rejection should show, to establish a prima facie case for unpatentability, where §112 support resides in the [earlier application] for each instance of specific subject matter relied upon in the [later filed patent reference], including an explanation why the [earlier application] would still be recognized by the artisan as providing support if not “word for word” the same as the later text or drawings. Mere reference to the text or drawings . . . is not sufficient.

(Id. (emphasis added)). In other words, in order to be sustained on an appeal to the BPAI when making a rejection that is based upon a patent reference that requires a critical reference date that is equal to the filing date of an earlier-filed application in order to constitute “prior art,” the Office must specifically point out the portions of the earlier-filed patent application that provide adequate §112 support for all relied upon subject matter in a later-filed patent reference that is used by the Office to make a rejection. The Office must also provide an explanation as to why an artisan would recognize the earlier filed application as providing such support for the subject matter in the later filed patent reference.

Under the above standard, Applicant respectfully submits that the Office has failed to satisfy its burden to produce a factual basis establishing that the subject matter of Cohen ‘330 relied upon by the Office is properly supported by the Cohen Parent (Cohen ‘993). Accordingly, the present rejections could not be sustained on an appeal, and should therefore be withdrawn.

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<sup>1</sup> While *Ex parte Traversat, et al.* involved the issue of whether a published patent application was entitled to a critical reference date equal to the filing date of earlier provisional applications that the published application claimed priority to, the same principles of law articulated by the BPAI in that case would apply to the issue of whether an issued CIP patent is entitled to a critical reference date equal to the filing date of an earlier non-provisional patent application that the CIP patent claimed priority to.

In the outstanding Office Action, the Office has relied upon the disclosure found at col. 5, lines 5-12, of Cohen ‘330 in formulating the claim rejections. However, this portion of Cohen ‘330, or any similar disclosure, is not found in the Cohen Parent (Cohen ‘993), nor is such disclosure of Cohen ‘330 otherwise supported by any disclosure in the Cohen Parent (Cohen ‘993). Accordingly, such disclosure by Cohen ‘330 is not entitled to a reference date that is any earlier than the actual filing date of Cohen ‘330, which is 10/12/1999. This reference date for the subject matter of Cohen ‘330 relied upon by the Office is after the present Applicant’s priority date of 04/28/1999, such that Cohen ‘330 does not constitute prior art under §102(e).

In response to the above arguments, which have been previously asserted by the Applicant, the Office has stated as follows:

Cohen ‘993 clearly teaches on Figure 3, the advertisers being in communication with stations 1, 2 and 3, the advertiser determining which advertisements it wishes to display or does not wish to display (col. 4, lines 64 to col. 5, lines 1-3). The stations 20, 22 and 24 receive and stores advertisers profiles, message content and coordinated scheduling data received by the advertisers (col. 5, lines 24-28).

(see Office Action dated 04/19/2007 at p. 5). Notably, the Office made no apparent attempt to correlate such alleged teachings of the Cohen Parent (Cohen ‘993) with the specific subject matter disclosed in col. 5, lines 5-12, of Cohen ‘330, which the Office relies upon in making the present rejections. Applicant will address each of the portions of the Cohen Parent (Cohen ‘993) that are cited by the Office in turn.

Applicant respectfully submits that the Office is reading more into Figure 3 of the Cohen Parent (Cohen ‘993) than is actually there. As described in the Cohen Parent (Cohen ‘993), Figure 3 illustrates “data communication flow paths” between various components of a system (col. 3, lines 36-39). Applicant notes that, while Figure 3 includes a block purporting to represent an advertiser (block 28), all three of the data communication flow paths that are associated with the advertiser’s block (28) lead *toward* the advertiser’s block (28), with none leading *away from* the advertiser’s block (28). If Figure 3 provides adequate §112 support for any alleged teaching by Cohen ‘330 of “providing advertising customers the opportunity to electronically order display of advertising content at display screen locations selected by the advertising customers via an advertising customer interface,” why does Figure 3 not show any data communication flow paths leading *away from* the advertiser’s block (28)? In fact, all of the

other blocks in Figure 3 of the Cohen Parent (Cohen ‘993) have arrows in both directions (i.e., to and from communicating components) for every single communication flow path. Thus, it is clear that the unidirectional nature of the arrows representing the data communication flow paths that are directly associated with the advertiser’s block (28) in Figure 3 of the Cohen Parent (Cohen ‘993) was intentional and not trivial.

The specification of the Cohen Parent (Cohen ‘993) further supports the conclusion that Figure 3 of the Cohen Parent (Cohen ‘993) does not provide §112 support for the subject matter in Cohen ‘330 relied upon by the Office. In particular, the only electronic activity involving the advertiser apparently described in the Cohen Parent (Cohen ‘993) is the advertiser *receiving* billing via “e-mail, facsimile, or other means” (col. 5, lines 21-23). This is consistent with the only data communication flow paths that are associated with the advertiser’s block (28) in Figure 3 leading *toward* the advertiser’s block (28), with none leading *away from* the advertiser’s block (28). Again, the Cohen Parent (Cohen ‘993) is completely silent on the subject matter of Cohen ‘330 relied upon by the Office in rejecting Applicant’s claims (i.e., col. 5, lines 5-12, of Cohen ‘330). Given the above-noted shortcomings of Figure 3 of the Cohen Parent (Cohen ‘993), among other shortcomings, Applicant respectfully submits that the Office has erroneously relied on Figure 3 for the §112 support needed for the Cohen ‘330 reference to properly constitute §102(e) art for the subject matter relied upon by the Office.

With respect to the first passage of the Cohen Parent (Cohen ‘993) specification that is cited by the Office as allegedly providing adequate §112 support for an alleged teaching by Cohen ‘330 of “providing advertising customers the opportunity to electronically order display of advertising content at display screen locations selected by the advertising customers via an advertising customer interface,” Applicant notes that the first referenced passage states as follows:

Similarly, if a monitored parameter is not in accordance with that specified for the message, e.g. vehicle travelling at rate of speed too great for zipper message, vehicle in zone where it is raining and advertiser does not wish to display sunscreen message, etc., the controller selects an alternate message from the memory or receives a new message from the station.

(Col. 4, lines 64 to col. 5, lines 1-3 of the Cohen Parent (Cohen ‘993)). Applicant respectfully submits that this passage fails to describe an advertiser being able to “access a station via a

communications link” as described in Col. 5, lines 5-12, of Cohen ‘330 as relied upon by the Office. Indeed, the passage is completely silent as to how an advertiser orders the display of advertising content, and fails to even remotely suggest anything done via an advertising customer interface. The passage therefore does not provide adequate §112 support for any alleged disclosure of “providing advertising customers the opportunity to electronically order display of advertising content at display screen locations selected by the advertising customers via an advertising customer interface” in Cohen ‘330, such that the filing date of the Cohen Parent (Cohen ‘993) cannot be used as a critical reference date for such subject matter.

With respect to the second passage of the Cohen Parent (Cohen ‘993) specification that is cited by the Office as allegedly providing adequate §112 support for an alleged teaching by Cohen ‘330 of “providing advertising customers the opportunity to electronically order display of advertising content at display screen locations selected by the advertising customers via an advertising customer interface,” Applicant notes that the second referenced passage states as follows:

Pursuant to the invention, the individual fixed location stations 20, 22 and 24 store advertiser profiles, message content and coordinated scheduling data. The stations transmit data to the vehicle controller 16 in the form of programming data, message content and scheduling information.

(Col. 5, lines 24-28 of the Cohen Parent (Cohen ‘993)). Contrary to the Office’s suggestion, this passage mentions nothing about stations 20, 22, and 24 receiving anything *from the advertiser* – the passage is completely silent as to where the “advertiser profiles, message content and coordinated scheduling data” comes from. Applicant therefore respectfully submits that this passage fails to describe an advertiser being able to “access a station via a communications link” as described in Col. 5, lines 5-12, of Cohen ‘330 as relied upon by the Office. Furthermore, the passage is completely silent as to how an advertiser orders the display of advertising content, and fails to even remotely suggest anything done via an advertising customer interface. To the extent that the passage suggests electronic storage of content and scheduling data, it mentions nothing of how such content and data is put into the storage (e.g., whether done by an advertiser or via an advertising customer interface). This passage also therefore does not provide adequate §112 support for any alleged disclosure of “providing advertising customers the opportunity to electronically order display of advertising content at display screen locations selected by the

advertising customers via an advertising customer interface" in Cohen '330, such that the filing date of the Cohen Parent (Cohen '993) cannot be used as a critical reference date for such subject matter.

In view of the foregoing, Applicant maintains that the subject matter of the Cohen '330 patent relied upon in rejecting the claims of the present application is not prior art against any of those claims. Because the rejections in the Office Action dated 04/19/2007 improperly rely on Cohen '330 as prior art, they cannot be sustained. Applicant therefore respectfully requests that the rejections be withdrawn.

To the extent that any particular statement or argument by the Office in the pending Office Action has not been explicitly addressed herein, the same should not be construed as an acquiescence or admission by the Applicant that such statements or arguments by the Office are accurate or proper.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance. Should the Examiner wish to discuss the amendments or arguments made herein, Applicant invites the Examiner to contact the undersigned at (513) 369-4811 or via e-mail at [aulmer@fbtlaw.com](mailto:aulmer@fbtlaw.com).

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully Submitted,



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